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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,334	02/23/2004	Enrique Travieso	074869-0014	8709
20277	7590	06/27/2006		
MCDERMOTT WILL & EMERY LLP 600 13TH STREET, N.W. WASHINGTON, DC 20005-3096			EXAMINER VAUGHN, GREGORY J	
			ART UNIT 2178	PAPER NUMBER

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/784,334

Applicant(s)

TRAVIESO ET AL.

Examiner

Gregory J. Vaughn

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Action Background

1. This action is responsive to the application filing, application filed on 2/23/2004.
2. Acknowledgement is made to the applicant's submission of a Preliminary Amendment, filed 3/23/2005. In this amendment, applicant has canceled claims 1-21 and added new claims 22-48.
3. Claims 22-48 are pending in the case, claims 22, 33, 44 and 46 are independent claims.

Priority

4. Applicant's claim for domestic priority of US provisional application 60/449,571 filed 2/21/2003, under 35 U.S.C. 119(e) is acknowledged.

Specification

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

7. Claims 22-48 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

8. **Regarding claims 22-48**, the claimed invention fails to produce a useful, concrete or tangible result. The claimed invention as a whole must accomplish a practical application. That is, it must produce a *"useful, concrete and tangible result."* *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. (See MPEP 2106.) Usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459.

Applicant's invention is directed toward sizing content for language translation in a computer system, where the invention includes retrieving content, parsing the content for components, generating unique identifiers for

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the components, storing the identifiers and the components, and generating statistics on the components. Applicant's claims describe the steps to manipulate (retrieve, parse, generate, store and generate) the non-functional descriptive material (content or content components), but fail to describe a tangible result of the invention. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. A process that consists solely of the manipulation of an abstract idea is not concrete or tangible. See *In re Warmerdam*, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759 (Fed. Cir. 1994). See also *Schrader*, 22 F.3d at 295, 30 USPQ2d at 1459.

However, applicant's disclosure is directed toward steps related to displaying information to a user (see Figures 9-12). Displaying is a tangible result.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

"A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language."

10. Claims 22-27, 29-38, 40-44 and 46-48 are rejected under 35 U.S.C. 102(e) as being anticipated by Lakritz US Patent 6,526,426, filed 1/28/1999, patented 2/25/2003 (hereinafter Lakritz).

11. **Regarding independent claim 22**, Lakritz discloses retrieving content containing markup tags, the content being viewable by a browser in a first language. Lakritz recites: *"When a document is requested in a particular language, WebPlexer will go to that cell of the matrix and try to retrieve the corresponding document"* (column 36, lines 28-30) and *"This application integrates a machine translator in the end user's Web browser"* (column 1, lines 24-25). Lakritz discloses parsing the content into components. Lakritz

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recites: *"The Parser converts the document into the internal format"* (column 10, lines 14-15).

Lakritz discloses generating a unique identifier for each of the components. Lakritz recites: *"The master language is used to index into the TermDB using a key. The key is obtained from the string contained between <!--WPreplaceBegin -- > and <!--WPreplaceEnd .fwdarw. >tags"* (column 27, lines 13-15). As is well known in the database art, indexes and keys are used as unique identifiers within a database. Lakritz discloses storing the component and the unique identifier together. Lakritz recites: *"The Web server stores all of the translated Web pages locally"* (column 1, lines 32-33).

Lakritz discloses generating statistics for the components. Lakritz recites: *"The UsageLog contains a summary of country and language statistics"* (column 15, lines 47-48).

12. **Regarding dependent claim 23**, Lakritz discloses queuing the components for translation. Lakritz recites: *"The Workflow Manager module provides a Manager's Console 601, access to a Workflow Pipeline 602, and customizable Translation Resources 603. Translation queues 604 hold the incoming translated documents and outgoing documents to be translated"* (column 7, lines 28-32).

13. **Regarding dependent claim 24**, Lakritz discloses retrieving all the content containing markup tags from a data source in a first language. Lakritz

recites: *"The Developer module controls all aspects of content navigation and delivery for the entire site so that a visitor will always be served in the most appropriate language"* (column 6, lines 20-23).

14. **Regarding dependent claim 25**, Lakritz discloses the components as at least a text segment. Lakritz recites: *"The invention utilizes an intuitive user interface for managing document translation for multilingual Internet Web sites, documents, data streams, and non-text files"* (column 2, lines 12-14).

15. **Regarding dependent claim 26**, Lakritz discloses the use of mathematical algorithm for generating a unique identifier. As described above Lakritz discloses the use of indexes and keys. Indexes are implemented with a scalar value where an offset amount is used to identify subsequent indices. An offset amount used with a scalar value is a mathematical algorithm.

16. **Regarding dependent claim 27**, Lakritz discloses using the unique identifiers to access the components. As described above Lakritz discloses indexes and keys, which are well know to be unique identifiers. Indexes and keys are also well known to be used within databases to access data. In fact indexes are frequently created for enhancing data extraction (i.e. to speed up access).

17. **Regarding dependent claim 29**, Lakritz discloses human translation. Lakritz recites: *"These translation resources include both automated translation tools as well as human translators"* (column 2, lines 34-36).

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18. **Regarding dependent claim 30**, Lakritz discloses at least two different languages, where the languages are at least English or French in Figure 12 at reference signs 1210 and 1211.
19. **Regarding dependent claim 31**, Lakritz discloses generating a web page having links. Lakritz recites: "All accesses to relative links within the requested document stay within that directory" (column 18, lines 65-67).
20. **Regarding dependent claim 32**, Lakritz discloses parsing as described above. It is well known in the markup language arts that parsing is based upon the markup language tags.
21. **Regarding independent claims 33, 44 and 46**, the claims are directed toward a system, program and method for the method of claim 22, and are rejected using the same rationale.
22. **Regarding dependent claim 34**, the claim is directed toward a system, for the method of claim 23, and is rejected using the same rationale.
23. **Regarding dependent claim 35**, the claim is directed toward a system, for the method of claim 24, and is rejected using the same rationale.
24. **Regarding dependent claim 36**, the claim is directed toward a system, for the method of claim 25, and is rejected using the same rationale.
25. **Regarding dependent claim 37**, the claim is directed toward a system, for the method of claim 26, and is rejected using the same rationale.

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26. **Regarding dependent claim 38**, the claim is directed toward a system, for the method of claim 27, and is rejected using the same rationale.
27. **Regarding dependent claim 40**, the claim is directed toward a system, for the method of claim 29, and is rejected using the same rationale.
28. **Regarding dependent claim 41**, the claim is directed toward a system, for the method of claim 30, and is rejected using the same rationale.
29. **Regarding dependent claim 42**, the claim is directed toward a system, for the method of claim 31, and is rejected using the same rationale.
30. **Regarding dependent claim 43**, the claim is directed toward a system, for the method of claim 32, and is rejected using the same rationale.
31. **Regarding dependent claim 47**, Lakritz discloses the use of cookies. Lakritz recites: "*WebPlexer provides three ways by which the country of an incoming request is determined. Automatic country selection Manual country selection Cookie-based country selection*" (column 21, lines 19-25).
32. **Regarding dependent claim 48**, Lakritz discloses the use of forms. Lakritz recites: "*The Visitor module intercepts input text that is submitted using an HTML form (e.g., a customer feedback form), and writes it into a form database 205*" (column 4, lines 12-14).

Claim Rejections - 35 USC § 103

33. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

"(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

34. Claims 28, 39 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lakritz.

35. **Regarding dependent claim 28**, Lakritz discloses generating statistics as described above Lakritz fails to explicitly describe the statistics as a file count, page count, text segment count, unique text segment count, unique text segment word count or a word count. However, Lakritz clearly discloses "a process for managing, tracking, accounting and translating multilingual electronic content" (claim 1), where the accounting includes "analyzing all of the project components in sufficient detail to determine the cost and resource requirements" (claim 2). Determining the cost of a translation of a electronic document would obviously include a word count or a page count.

Therefore, it would have been obvious, to one of ordinary skill, at the time the invention was made to use the translation management system that determines the cost of content translation of Lakritz to determine the cost of

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the translation based on a word count in order to provide "*a translation management system that allows the user to easily manage, schedule, and track translation resources*" (Lakritz, column 2, lines 4-6).

36. **Regarding claim 39 and 45**, the claims are directed to a system and a program for the method of claim 28, and are rejected with the same rationale.

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Conclusion

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory J. Vaughn whose telephone number is (571) 272-4131. The examiner can normally be reached Monday to Friday from 8:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen S. Hong can be reached at (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Gregory J. Vaughn
Patent Examiner
June 23, 2006